

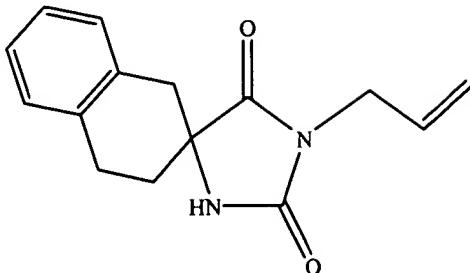
REMARKS/ARGUMENTS

Upon entry of the present amendment, claims 1, 6, 8, 12, 13 and 57-66 will be pending in this application and presented for examination. Claims 2, 3, 5, 7, 9-10 and 14-56 have been canceled without prejudice or disclaimer. Claims 4 and 11 were previously canceled. Claims 1, 6 and 13 have been amended. Claims 57-66 are newly added and are drawn to a preferred embodiment of N-containing heterocyclic compounds and to polymeric compositions comprising the same. Applicants have elected a new species for examination.

Applicants believe no new matter is present in this or any other portion of the present amendment. Applicants have amended claims 1 and 6 to recite a preferred embodiment of the invention. The amendment to claim 1 finds support in claim 1 as originally filed wherein A is CR¹R² and X is C(O). Support for new claims 57-66 can be found, for example, in claims 13 and 15-28 as originally filed. Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicants' remarks are presented in the order in which the corresponding issues were raised in the Office Action.

I. REQUEST FOR CONTINUED EXAMINATION AND ELECTION OF SPECIES

Claim 1 no longer encompasses the previously elected species or its expanded embodiments (i.e., where A is CR¹R²; and R¹ and R² are each ethyl, propyl or butyl; Q is NH, X is -C(O)- and Z is CH₂). Applicants respectfully request continued examination based on the election of the following compound, 7,8-benzo-3-allyl-1,3-diazaspiro[4.5]decane-2,4-dione (BADD) (*see*, compound 7 in Table 1, and the description at page 7, lines 14-15 and page 20, lines 20-24). The elected species has the following structure:



II. REJECTION UNDER 35 U.S.C. § 103

The Examiner has rejected claims 1, 3 and 8 under 35 U.S.C. § 103(a) as allegedly being obvious in view of Neukam *et al.* (DE 2437917). The Examiner alleges that Neukam *et al.* teach hydantoin compounds which are structurally similar to the instantly claimed compounds. Further, the Examiner alleges that one skilled in the art would be motivated to make the compounds embraced by the cited art to arrive at the instantly claimed compounds with the expectation that structurally similar compounds would possess similar activity (i.e., as fireproofing agents). To the extent the rejection is applicable to the amended set of claims, Applicants respectfully traverse the rejection.

As set forth in M.P.E.P. § 2143:

[t]o establish a *prima facie* case of obviousness, *three* basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

All three elements set forth above must be present in order to establish a *prima facie* case of obviousness. Applicants assert that a *prima facie* case of obviousness has not been established.

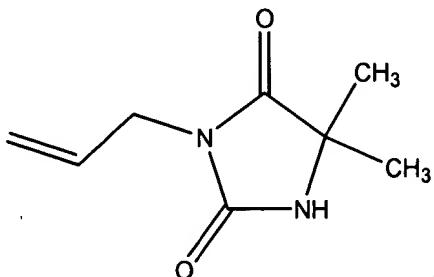
1. There is No Suggestion or Motivation to Modify the Reference

Applicants state that there is simply no motivation or suggestion provided in the cited reference to modify its teaching in the way the Examiner has contemplated. Obviousness

can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the reference itself or in the knowledge generally available to one of ordinary skill in the art.

In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Neukam *et al.* do not teach or suggest the presently claimed compounds, but instead discloses certain hydantoin compounds that make good **fireproofing agents**. The preferred species of Neukam *et al.*, set forth on page 2, line 18, bridging to page 3, line 2, are 3-allyl-5,5-dimethylhydantoin, 3-allyl-5,5-diphenyl-hydantoin, 1-methyl-3-allyl-5,5-dimethylhydantoin, 1-methyl-3-allyl-5,5-diphenylhydantoin, and 1-phenyl-3-allyl-5,5-dimethylhydantoin. 3-Allyl-5,5-dimethylhydantoin is the most preferred compound, which has the following structure:



In sharp contrast, Applicants teach that the claimed hydantoin compounds are **biocidal agents**. Neukam *et al.* simply do not teach or suggest that hydantoin compounds can alternatively be used as **biocidal agents**. Neukam *et al.* in no way teach or suggest that hydantoin compounds can also have biocidal properties. As such, one skilled in the art simply would not be motivated to modify the teaching of Neukam *et al.* to arrive at the instantly claimed hydantoin compounds because there is no incentive to do so. Applicants submit that there is simply no motivation or suggestion in the disclosure of Neukam *et al.* to modify the fireproofing hydantoin compounds to arrive at the instantly claimed biocidal agents. As such, Applicants respectfully request that the Examiner withdraw the rejection.

2. There is No Reasonable Expectation of Success

In addition, there is no reasonable expectation of success that the modification the Examiner contemplates will succeed. "Both the suggestion and the expectation of success must be found in the prior art, not the Applicants' disclosure." *In re Dow Chem. Co.*, 5 U.S.P.Q.2d 1529, 1532 (Fed. Cir. 1988).

Neukam *et al.* teach that certain hydantoin compounds have fireproofing properties. Neukam *et al.* do not teach or suggest that hydantoin compounds can also have biocidal properties. Thus, *a priori*, one skilled in the art would not expect that hydantoin compounds can be both fireproofing and biocidal. As such, one skilled in the art simply would not have an expectation of success of modifying the compounds as disclosed by Neukam *et al.* to generate biocidal compounds as currently taught and claimed.

Moreover, if one skilled in the art were motivated to prepare new fireproofing agents based on the preferred teachings to Neukam *et al.*, these compounds would most logically be compounds wherein R¹ and R² are alkyl groups not alkoxy or cyclized compounds as is currently taught and claimed. In view of the amendment to the claims, Applicants respectfully request that the rejection be withdrawn.

Appl. No. 09/535,348
Amdt. dated September 26, 2003
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group

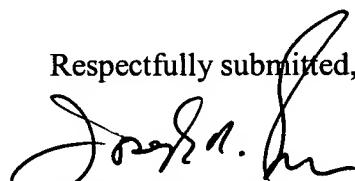
PATENT

III. CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,



Joseph R. Snyder
Reg. No. 39,381

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: 925-472-5000
Fax: 415-576-0300
Attachments
JS:sc
60025855 v1